

S/N 10/557,289

### **REMARKS**

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claims 1-28 are pending. The Examiner has acknowledged Applicants' species election. Claims 5-14 and claims 21-25 are withdrawn. Claims 3 and 4 have been amended as suggested by the Examiner. Claims 1, 2, 4, 20, and 26-28 have been further amended and are supported, for example, in the specification on page 1, paragraphs 008 and 009.

#### **New References Considered**

Applicants request that the Examiner add Kerlin (US 4,501,947) and Le Fur et al. (US 4,425,496) to the Notice of References Cited.

#### **§112, Second Paragraph:**

Claims 3 and 4 are rejected as being indefinite. Claims 3 and 4 are amended editorially as suggested by the Examiner and no longer contain the language found to be indefinite. Withdrawal of this rejection is requested.

#### **§102 Rejections:**

Claims 1, 2 and 18 are rejected as being anticipated by Schmidt (US Patent No. 3,538,308). This rejection is traversed.

Claim 1 is directed to a metal coating removing apparatus that removes a metal coating from the surface of a resin. Claim 1 requires, among other features, a first and second electrode that are arranged so as to be opposed to the metal coating provided on a surface of a resin, whereby discharge energy is supplied between the first and second electrode thereby removing the metal coating provided on the surface of the resin.

Schmidt is directed to a spark discharge device for punching perforations into a carrier that is disposed between a matrix and a spark gap. Schmidt neither describes nor suggests a device that removes a metal coating provided on the surface of a resin as is required by claim 1. (see column 1, lines 15-23).

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For at least this reason, claim 1 is not disclosed by Schmidt and should be allowed. Claims 2 and 18 depend from claim 1 and should be allowed for at least the same reason.

Claim 1 is rejected as being anticipated by Kerlin (US Patent No. 4,501,947). This rejection is traversed.

Kerlin discloses an unbalance correction system that uses arc discharge generated between a conductive workpiece and two electrodes to melt and vaporize a minute spot on the surface of a workpiece, thereby removing material from the workpiece. (see column 3, lines 51-54, Fig.1). Kerlin neither describes nor suggests a device that removes a metal coating provided on a surface of a resin. Therefore Kerlin does not disclose all of the features in claim 1. For at least this reason, claim 1 is not disclosed by Kerlin and should be allowed.

§103 Rejections:

Claims 15-17 are rejected as being unpatentable as being obvious over Kerlin (US Patent No. 4,501,947) in view of Salsgiver (US Patent No. 4,931,613). This rejection is traversed.

Claims 15-17 depend on Claim 1. Kerlin fails to show all of the features of Claim 1 for the reasons given above. Salsgiver does not cure this deficiency. Therefore claims 15-17 should be allowed for at least the same reasons. Applicants are not conceding the correctness of the rejections for the features of claims 15-17.

Claim 20 is rejected as being unpatentable over Kerlin in view of Le Fur et al. (US 4,425,496; newly cited) and Yuasa et al. (U.S. 5,523,687; newly cited). This rejection is traversed.

Claim 20 is directed to a metal coating removing method for removing a metal coating provided on a surface of a resin which involves arranging a first electrode and a second electrode so that they are opposed to the metal coating provided on the surface of the resin; and supplying discharge energy between the first electrode and the second electrode so as to allow discharging to occur between the first electrode and the second electrode, thereby removing the metal coating.

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Nothing in Kerlin discloses a method for removing a metal coating from a resin. Le Fur et al. is directed to a process for removing a metal coating from a strip of dielectric material by creating a Corona discharge between the tip of an electrode and the metal coating wherein the metal coating is removed. (See Col. 1, lns. 25-26; Col. 2, lns. 33-39 and Fig. 1). Yuasa is directed to a method of electrode etching an electrode pattern in conductive film by contacting an electrode to the conductive film covering the surface of a substrate. (See col. 1, lines 55-68). Neither Le Fur et al. nor Yuasa suggest arranging two electrodes so that they are opposed to the metal coating and supplying discharge energy between the two electrodes so as to allow discharging to occur between the two electrodes, thereby removing the metal coating.

For at least these reasons that claim 20 is not obvious in view of Kerlin, Le Fur et al. and Yuasa, claims 26-28 that depend therefrom should also be allowed.

Conclusion:

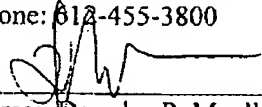
Applicants respectfully assert that the pending claims are in condition for allowance.

Please charge any additional fees or credit any overpayment to Deposit Account No. 50-3478.

Respectfully submitted,

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